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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/814,625

03/22/2001

Peter Gleichenhagen

tesa AG 719-KGB

6272

27384

7590

09/04/2002

KURT BRISCOE
NORRIS, MCLAUGHLIN & MARCUS, P.A.
220 EAST 42ND STREET, 30TH FLOOR
NEW YORK, NY 10017

EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 09/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/814,625

Applicant(s)

GLEICHENHAGEN ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/22/01;05/11/01;06/11/01;06/18/0103/29.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Priority

1. ***Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.***

Claim Rejections - 35 USC § 112

2. ***The following is a quotation of the second paragraph of 35 U.S.C. 112:***

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. ***Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***

A) *The recited "A process for preparing hot-melt pressure-sensitive adhesives----- and pressure-sensitively adhesive articles produced therefrom" per claim 1 constitutes indefinite subject matter as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are those steps, which recite how the pressure-sensitive adhesives are actually produced. Further the claim includes ambiguous subject matter since it includes overlapping inventions, i.e., "a process" and "an article"(see Ex parte Lyell, 17 USPQ2d 1548(Bd. Pat. App. & Inter. 1990)).*

B) *The recited "with polymer contents between 68% by weight and 87% by weight of gel-free, molecularly-dispersely meltable and polymer particles—" per claim 1 constitutes indefinite subject matter as per a) it not being readily ascertainable as to the exact entity that the contents are being based on, b) it not being clear as to how the "gel-free, molecularly dispersely meltable and polymer particles" further limits the claim, c)*

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the intended meaning of "molecularly dispersely meltable" and d) it is not readily ascertainable as to how the recited "polymer contents" further limits the antecedently recited "polyacrylate".

C) The recited "such as"(both occurrences) per claim 2 and "preferably"(all occurrences) per claims 3, 4, 5 and 9 constitute indefinite subject matter as per it not being readily ascertainable as to how said objectionable phrases further limit the claims, i.e., it is not readily ascertainable as to if the limitations following the phrases are a part of the claimed invention.

D) The recited "in an overall concentration of up to 4 % by weight" per claim 3 constitutes indefinite subject matter as per it not being readily ascertainable as to the exact entity that said contents are being based on.

E) The recited "the polymer" per claim 4 constitutes indefinite subject matter as per the non-express establishment of proper antecedent basis. Perhaps applicant intends "the polyacrylate".

F) The recited "during the polymerization, preferably by comonomers from the group of the vinyl ethers, preferably--- and also by styrene or by hydrophilic rosins in amounts of up to 10% by weight based on polymer" per claim 4 constitutes indefinite subject matter as per a) non-express establishment of proper antecedent basis for "the polymerization"; b) it is not readily ascertainable as to how the recited "by comonomers" further limits the antecedently recited "polymerization", perhaps applicant intends "of comonomers"; c) the use of improper Markush language, use of "selected from the group consisting of" is proper and is suggested; d) it is not readily ascertainable as to how the "hydrophilic rosins" further limit the antecedently recited "comonomers"; e) the non-express establishment of proper antecedent basis for "polymer"; f) it is not apparent

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as to the exact entity that said contents are qualifying, i.e., the “hydrophilic rosins” only or the other recited members also.

G) The recited “linearly polymerizing, water-insoluble initiators” per claim 5 constitutes indefinite subject matter as per it not being clear, from the language as claimed, what is being linearly polymerized.

H) The recited “the polymer dispersion” per claim 7 engenders the non-express establishment of proper antecedent basis.

I) The recited are filmed” per claim 7 constitutes indefinite subject matter as per it not being readily ascertainable as to the intended meaning of said claim language, i.e., does applicant intend “photos having been taken” or “formed into a film”.

J) The recited “based on acrylic polymer” per claims 8 and 9 constitute indefinite subject matter as per it not being readily ascertainable as to how said “acrylic polymer” further limits the antecedently recited “polyacrylate”.

K) The recited “and/or” phrases per claims 8 and 10 constitute indefinite subject matter as per it not being readily ascertainable as to how said objectionable phrases further limit the claims.

L) The recited “the acrylic polymer” per claim 10 engenders the non-express establishment of proper antecedent basis.

K) The recited “Method of using the hot-melt pressure sensitive adhesives” per claim 11 constitute indefinite subject matter as per the claim language merely reciting a utility without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

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thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention embraces or overlaps two different statutory classes of inventions, i.e., a process and a product.

Conclusion

5. *Applicant is herein apprised that any further action, on the merits or otherwise, is herein being held in abeyance pending a response to the matter supra.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
September 3, 2002